

11/24/07



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Initial application of:)	Art Unit: 2451
)	
Lakshmi Arunachalam)	Examiner: H. Phillips
)	
Serial No. 09/863,704)	
)	
Filing Date: May 23, 2001)	
)	
Title: NETWORK TRANSACTION)	
PORTAL TO CONTROL)	
MULTI-SERVICE PROVIDER)	
TRANSACTIONS)	
)	

DUTY OF CANDOR DISCLOSURE UNDER 37. C.F.R §1.56

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Honorable Commissioner:

In accordance with 37 C.F.R. §1.56, please accept this Duty of Candor Disclosure.

COMMENTS

Microsoft Corporation filed complaint CV 08 05149 in the United States Federal Court for the Northern District of California against the owner of several of the parent patents (applications) to this pending application 09/863,704. The motion to dismiss Microsoft's complaint was granted by Judge Alsup on February 17, 2009, in which he

ruled that, failing Microsoft amending its claims by March 3, 2009, all of Microsoft's claims will be dismissed with prejudice. Microsoft amended its complaint on March 3, 2009, which will be supplied in an Information Disclosure Statement in this application. Judge Alsup's ruling stated that "Microsoft is using counterfeit logic to manufacture a controversy where none exists.", regarding Microsoft's "effort to open a new front in a new district arising out of patent litigation already proceeding in another district", namely the Delaware Court under the Honorable Judge Farnan.

Microsoft had asked for a declaratory judgment of enforceability based on alleged inequitable conduct against the present inventor in procuring the following parent patents: 5,778,178 (08/700,726), 6,212,556 (09/296,207) and 7,340,506 (09/792,323). All of these patents are priority applications to the present application. The complaint and dismissal order have already been supplied in an Information Disclosure Statement in this application and are currently in the record.

Microsoft alleged that the inventor Ms. Lakshmi Arunachalam failed to disclose certain documents during the course of prosecution of the three patents, namely, 5,778,178 (08/700,726), 6,212,556 (09/296,207) and 7,340,506 (09/792,323). In particular, Microsoft alleged that the inventor did not disclose the following three documents: 1) SMI RFC-1155, "Structure and Identification of Management Information for TCP/IP Based Internets", published May 1990, 2) MIB II RFC-1213, "Management Information Base for Network Management for TCP/IP Based Internets: MIB-II", published March 1991, and 3) SNMP RFC-1157, "A Simple Network Management Protocol (SNMP)", published May 1990. All three of these SNMP documents have already been supplied to the Patent Office in an Information Disclosure in the present

application. Also, the inventor had disclosed SNMP to the USPTO during initial prosecution in Column 7, Line 63, in the 5,778,178 patent and in several pages of the provisional patent application having the Serial Number 60/006,634 filed on November 13, 1995. The inventor had worked on porting SNMP software across multiple UNIX platforms, but had neither seen nor read the SNMP standards' documents during initial prosecution. In a previous Rule 56 disclosure filed in this application, the attorney's statement that "the applicant did not know of the existence of these documents during initial prosecution.", simply meant that the applicant/inventor had neither seen nor read the SNMP standards' documents. The attorney inadvertently filed the previous disclosure without sending it to the inventor for review.

Microsoft also alleged that the inventor not only knew of these documents, but copied portions of them into the specification of these patents.

Microsoft, in their complaint, presented the Table below, but omitted in their Table many lines from the 5,778,178 patent. For example, Microsoft omitted Lines 29-34 from Column 8 of the 5,778,178 patent, thereby leaving out the context of a Web transaction, causing a possible mistaken impression that SNMP and a Web transaction are one and the same. Likewise, Microsoft has made numerous other omissions in their Table. For example, Lines 25-37 of Column 8 of the 5,778,178 patent are as follows: "Each object in the DOLSIB has a name, a syntax and an encoding. The name is an administratively assigned object ID specifying an object type. The object type together with the object instance serves to uniquely identify a specific instantiation of the object. For example, if object 610 is information about models of cars, then one instance of that object would provide user 100 with information about a specific model of the car while

another instance would provide information about a different model of the car. The syntax of an object type defines the abstract data structure corresponding to that object type. Encoding of objects defines how the object is represented by the object type syntax while being transmitted over the network."

Likewise, Microsoft has omitted many lines from the 5,778,178 patent and the Provisional Patent application number 60/006,634 in their Table, again leading to a possible mistaken impression.

<u>RFC 1156 Excerpts</u>	<u>'178 Patent Excerpts</u>
<p>Managed objects are accessed via a <u>virtual information store</u>, termed the Management Information Base or MIB. Objects in the MIB are defined using Abstract Syntax Notation One (ASN.1) [8] defined in the [Internet standard] SMI.</p>	<p>DOLSIBs are <u>virtual information stores</u> optimized for networking.</p>
<p>In particular, <u>each object has a name, a syntax, and an encoding. The name is an object identifier, an administratively assigned name, which specifies an object type. The object type together with an object instance</u></p>	<p><u>Each object in the DOLSIB has a name, a syntax and an encoding. The name is an administratively assigned object ID specifying an object type. The object type together with the object instance serves to uniquely identify a specific instantiation of the object. The syntax of an object type defines the abstract data structure corresponding to that object type. Encoding</u></p>
<p><u>serves to uniquely identify a specific instantiation of the object.</u> For human convenience, we often use a textual string, termed the OBJECT DESCRIPTOR, to also refer to the object type.</p>	<p><u>of objects defines how the object is represented by the object type syntax while being transmitted over the network.</u></p>
<p><u>The syntax of an object type defines the abstract data structure corresponding to that object type.</u> The ASN.1 language is used for this purpose. However, the SMI [12] purposely restricts the ASN.1 constructs which may be used. These restrictions are explicitly made for simplicity.</p>	<p>12. A method for enabling object routing on the World Wide Web, said method for enabling object routing comprising the steps of: <u>creating a virtual information store</u> containing information entries and attributes; </p>
<p><u>The encoding of an object type is simply how that object type is represented using the object type's syntax. Implicitly tied to the notion of an object type's syntax and encoding is how the object type is represented when being transmitted on the network.</u> The SMI specifies the use of the basic encoding rules of ASN.1 [9], subject to the additional requirements imposed by the SNMP.</p>	<p>15. The method claim 12 wherein said step of associating each of said information entries and said attributes with said object identity further includes the step of <u>storing a name, a syntax and an encoding for each of said object identities.</u></p> <p>16. The method in claim 15 wherein <u>said name of said object identity specifies an object type.</u></p>

The inventor/applicant admits that these SNMP documents were not disclosed to the Patent Office in the previous cases. She had already disclosed SNMP in the Provisional patent application having the Serial Number 60/006,634 filed on November 13, 1995 and in the 5,778,178 patent. The inventor further admits that there is language in her specification that is similar, though NOT IDENTICAL, to that contained in these SNMP documents, and her specification also has language that Microsoft chose to omit in the Table above that clearly shows the innovative context that was totally unrelated to SNMP. The words in her specification connote a unique, novel and inventive meaning (distinctly different from SNMP) that she has taught extensively throughout the parent patents. For example, SNMP has nothing to do with a "checking account" on a Web page, or a "car" POSvc application on the Web offered by a Web Merchant. SNMP is about managing physical devices on a physical network. SNMP does not support object operations. Besides, the Web is a simple windowing network atop the Internet. The Web and Internet are not the same. The inventor wrote the sentences appearing in the Provisional patent application having the Serial Number 60/006,634 filed on November 13, 1995 and in the 5,778,178 specification and approved them during initial prosecution of the Provisional and the 5,778,178 patents. The attorney in the previous Rule 56 disclosure did not mean that "the inventor is not sure where the similar language appearing in the specification came from" - in the sense of not knowing who wrote it, he simply meant that the applicant/inventor had not read the SNMP standards' documents and did not realize that the language was similar. The attorney inadvertently filed the previous disclosure without sending it to the inventor for review.

Microsoft also alleged that the inventor failed to notify the Patent Office about her PCT application No. PCT/US96/18165 published in 1997 as WO 97/18515 in the case of patent number 6,212,556 (09/296,556) filed April 21, 1999. Since the '556 patent application was a continuation-in-part, it contained new matter, and claims to new matter.

The inventor admits that her PCT application was published in 1997, more than one year before the filing date of the application for the '556 patent, and that the application for the '556 patent was a CIP and contained new matter. The inventor did not disclose the PCT application to the examiner. However, as Microsoft states in their complaint, the PCT application was almost identical to the original parent application U.S. Patent number 5,778,178 (08/700,634). This original US parent application was on file at the Patent Office and known to the examiner through the chain of priority claimed in the application for the '556 patent. Since the PCT application was almost identical to the original parent, it did not contain any of the new matter. Therefore, the inventor was therefore not required to disclose it to the examiner since it was cumulative. In any case, a copy of PCT/US96/18165 has already been supplied in an Information Disclosure Statement in the present application.

To the extent that the present examiner concludes that the material in the SNMP RFCs 1155, 1213, 1157 is relevant to the present case, further examination is invited by the inventor. However, it is the inventor's belief that these SNMP documents are not material to the present claims. The present claims are directed to real-time transactions related to Web pages involving switching in real-time between a plurality of sellers/Web Merchants. The SNMP RFC documents simply do not discuss switching in real-time

between a plurality of sellers/Web Merchants presenting multiple Web pages so that real-time transactions can take place or that a user interactively settles multiple Web transactions from different sellers/Web Merchants simultaneously.

Example claims from the current case are Claims 87, 88, 89, 108:

Claim 87: A method of permitting an online transaction in real-time by a user with at least one computing device on the World Wide Web, comprising the steps of:

presenting a first Web page from a first server allowing a user to choose a transaction from a plurality of possible transactions;

presenting a second Web page allowing said user to display said second Web page on said computing device and to interactively enter into said transaction with a particular seller;

switching said user from said first server to a payment server remote from said first server allowing said user to interactively settle said transaction wherein said user communicates directly from a user device to said payment server;

allowing said user to communicate by electronic mail with said seller.

Claim 88: The method of claim 87 further comprising the step of switching said user back from said payment server to said first server when said transaction is settled.

Claim 89: The method of claim 87 further comprising the step of presenting a second web page allowing said user to interactively enter into a second transaction with a different particular seller, and wherein said user interactively settles both transactions simultaneously.

Claim 108: A real-time online, two-way transaction service running on at least one processor and operating on the World Wide Web comprising:

a content manager executing on a first server supporting a first web page on the World Wide Web, said content manager allowing access by a user to a plurality of possible transactions from a plurality of sellers;

a user transaction manager allowing said user to enter into a first real-time transaction using a second web page, said user transaction manager also allowing said user to enter into a second real-time transaction using a third web page;

an account settling manager allowing said user to communicate with a payment program running on a second server remote from said first server, wherein said user can settle an account relating to said first transaction and said second transaction simultaneously;

a switching component that temporarily switches said user from said first server to said second server to allow settling of said account, wherein said user communicates directly from a user device to said payment program;

a communication module allowing said user to communicate with at least one of said sellers by electronic mail.

None of the three SNMP RFC documents mention anything about a Web page. None of them mention switching a user in real-time between a plurality of sellers/Web Merchants. None of them mention switching a user from a first server to a payment

server. None of them mention a user interactively settling multiple Web transactions from different sellers/Web Merchants simultaneously. None of them mention electronic mail. Similar arguments apply to the other claims.

The Federal Circuit in the case Rohm & Haas Co. v. Crystal Chemical Co., 772 F.2d 1556, 220 U.S.P.Q. 289, 301 (Fed. Cir. 1983) has discussed what, if anything, can be done in the PTO during prosecution to cure or overcome possible previous misconduct.

There has been no misconduct, as alleged by Microsoft. However, in an abundance of caution, the inventor/applicant hereby applies the formula given by the Federal Circuit to cure or overcome possible previous misconduct. The formula given by the Federal Circuit is a) the applicant must expressly advise the PTO of the existence of a prior misrepresentation, stating specifically where it resides; b) the applicant must advise the PTO of the actual facts, if the prior misrepresentation was factual, and must indicate that further examination may be required; and c) the applicant must establish the patentability of the claimed subject matter.

Thus, following this formula: a) The inventor has disclosed that there is an allegation of inequitable conduct in a parent case, and that the allegation names documents that were not submitted to the examiner at that time. The applicant admits that she did not submit these SNMP documents in the parent case, and has submitted them in the present case. She had already disclosed SNMP in the 5,778,178 in Column 7, Line 63, and in the Provisional patent application having Serial number 60/006,634, filed on November 13, 1995 reinforcing that she had no deceptive intent nor has there

been any misrepresentation. b) The inventor does not believe these SNMP documents to be material; however, to the extent the PTO feels they are material, the inventor invites the examiner to use these documents in the present application. c) The applicant has argued how the claims in the current application are patentable over these SNMP documents, since these SNMP documents do not teach Web pages, nor switching in real-time between a plurality of sellers/Web Merchants, nor that user interactively settles multiple Web transactions from different sellers/Web Merchants simultaneously, nor electronic mail.

Respectfully Submitted



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 with sufficient postage.

On: MARCH 4, 2009

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